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IN THE

Supreme Court of the United States

OCTOBER TERM, 1970

No. 711

BECKMAN INSTRUMENTS, INC. and
LELAND C. CLARK, JR., *Petitioners,*

v.

CHEMTRONICS, INC. and J. RYAN NEVILLE, *Respondents.*

PETITION FOR REHEARING AND RECONSIDERATION OF DENIAL OF WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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FORTAS AND KOVEN

December 31, 1970

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On December 14, 1970 this Court denied the Petition for a Writ of Certiorari in this matter. The Petition had been filed on September 17, 1970.

On October 19, 1970, this Court granted the Petition for a Writ of Certiorari in No. 338, *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation*. One of the "Questions Presented" listed in these two petitions (the present case, No. 711, and *Blonder-Tongue*, No. 338) relates to the same subject: namely, the standard to be applied to measure whether a patent is invalid by reason of the acts or omissions of an applicant in the course of proceedings in the Patent Office. *Blonder-Tongue* (No. 338) presents the issue in connection with an allegedly incom-

plete and misleading representation to the Patent Office. The present case (No. 711) concerns the failure to advise the Patent Office of allegedly relevant prior art.

Petitioners herein respectfully urge that this Court grant the present petition for rehearing and reconsideration of the denial of the writ in this case, and that the two cases be set for argument concurrently.

Reasons for Granting This Petition

In No. 338, the *Blonder-Tongue* case, the Petitioner presented the following as one of the three "Questions Presented":

> Has a patentee (University of Illinois Foundation) any standing in a court of equity where, in the words of the Court of Appeals in this cause, the patentee
>
> "affirmatively presents a half-truth to the patent office in order to overcome a rejection,"
>
> knowing
>
> "that the whole truth would support rather than overcome the rejection;"
>
> or does such misconduct in the Patent Office, in line with previous pronouncements of this Supreme Court, but ignored by the Court of Appeals, bar relief of patent enforcement for unclean hands, and even constitute an antitrust violation, when such improperly obtained patent was used vigorously by the patentee and its exclusive licensee (JFD Electronics Corporation) to restrain competition?

In the present case, No. 711, Petitioners stated the following as one of the "Questions Presented":

> Did the Court of Appeals err in holding that, even in the absence of fraudulent conduct or willful

misrepresentation, there is an "uncompromising duty" to disclose prior art to the Patent Office, and that failure to do so invalidates the patent? Cf. *Precision Instrument Mfg. Co.* v. *Automotive Maintenance Machinery Co.*, 324 U.S. 806 (1945); *Walker Process Equipment Co.* v. *Food Machinery & Chemical Co.*, 382 U.S. 172 (1965).

Obviously, these questions present complementary issues.

The present case (No. 711) presents the question of the standard of duty in the setting of a finding by the Fifth Circuit that there was a failure to disclose relevant prior art, and the conclusion of that Court that such failure invalidated the patent.

Blonder-Tongue (No. 338) states the issue in terms of a case where there was an alleged misrepresentation: that is, a representation of "a half-truth" to the Patent Office in circumstances where statement of "the whole truth" as known to the applicant, would have led to rejection of the application. Factually, it is asserted that the applicant (Mayes) had executed an affidavit under Patent Office Rule 131 stating that his invention was made prior to the date cited by the Examiner as the date of publication of an invention by another (Isbell). Mayes did not disclose the fact, known to him, that the Isbell publication had appeared at an earlier date.*

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* The Respondents in No. 338 argue that this point—the alleged misrepresentation—is not truly pertinent to the issues before this Court: that the conflict between the circuits relates only to the Isbell patent and not to the Mayes patent, and that the issue of "misconduct before the Patent Office" involves only the Mayes patent which Respondents do not seek to enforce.

Presumably, the parties in No. 338 will brief and argue the question of patent office procedure, and this Court may rule upon the question. Unless the Court has before it the different, but related issue, which is presented by the facts of the present case (No. 711)—namely, whether and when there is an affirmative duty of disclosure—we respectfully submit that its judgment will be unnecessarily restricted and that it may add to the difficulties and conflicts which confront lower courts, the Patent Office, and the bar with respect to the important issues which are presented.

CONCLUSION

We respectfully urge that this Court vacate its order denying the Writ of Certiorari in No. 711 and grant the Petition in this case so that the question presented may be heard concurrently with No. 338.

Respectfully submitted,

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CERTIFICATE

Abe Fortas, pursuant to Rule 58 of the Rules of Practice of this Court hereby certifies that he is counsel for Petitioners; that this Petition for Rehearing is presented in good faith and not for purposes of delay and that the grounds upon which Petitioners seek Rehearing are confined to intervening circumstances of substantial effect arising subsequent to the filing by Petitioners of their Petition for a Writ of Certiorari herein.

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